

REMARKS

The Final Office Action of September 21, 2010 has been carefully considered. No new amendments have been presented and reconsideration of this application, and withdrawal of the rejection of the pending claims, is respectfully requested.

Summary of Office Action

Turning now, to the office action, the Examiner has limited the examination to claims 1 - 5.¹ Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herron (US 2005/0157921) in view of Tagami et al. (US 5,237,425; "Tagami").

Arguments in Traversal of Rejection

In response to the rejection of claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Herron in view of Tagami, Applicants submit herewith the following arguments in traversal of the rejections. Considering independent claim 1, Applicants continue to submit that the rejection fails to set forth a *prima facie* case of obviousness.

First, the Examiner fails to properly support the alleged basis for the combination. Considering the basis for the alleged combination (see pp. 4-5 of final office action), at best the basis is merely a recitation of Applicants' claim language, rather than an independent assessment of what one of skill in the art would have been motivated to do. As the basis for combination improperly relies on Applicants' claim language, and as such can only demonstrate that the Examiner has engaged in hindsight reconstruction, Applicants respectfully submit that the Examiner has failed to establish a proper basis for the combination. The Examiner is respectfully reminded that pursuant to MPEP §2141, "[o]bviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

(A) Ascertaining the differences between the claimed invention and the prior art;
and

(B) Ascertaining the differences between the claimed invention and the prior art;
and

¹ Applicants continue to urge that the requirement for restriction is improper, and await a decision on the petition submitted July 23, 2009 in this regard. Pending an upcoming decision on said petition, Applicants

(C) Resolving the level of ordinary skill in the pertinent art.” (MPEP §2141, *citing KSR, 550 U.S. 287, 82 USPQ2d 1385, 1391 (2007) and Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)*). It is only after the Examiner has established the Graham factual findings and concluded that the claimed invention would have been obvious that the burden shifts to the Applicant to show an error or to provide other evidence of nonobviousness. Lacking any such analysis by the Examiner, withdrawal of the rejection is respectfully requested for failure to provide any basis to establish that the alleged combination was obvious.

Second, even if considered, *in arguendo*, the combination of Herron and Tagami fails to set forth all the limitations recited in claim 1. As previously acknowledged by the Examiner,

Tagami'425 fails to show a method determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space.

The Examiner now contends that “newly supply arguments regarding previous stance” (Final Office Action, p. 2) have been provided and further urges that Tagami teaches the limitations previously acknowledged as missing from Tagami. Applicants respectfully urge that the Examiner has again failed to address Applicants’ outstanding request that the Examiner identify, on the record, why the contradictory interpretation of Tagami is now applicable in order to permit Applicants to respond accordingly.

In setting forth the rejection of claim 1, the Examiner relies upon alleged teachings of Tagami. In particular, the Examiner again alleges that Tagami teaches “determining, from the two-color input data, a rendering characteristic for each of the primary color and the

respectfully reserve the right to challenge the continued assertion of the restriction and the Examiner's refusal to examine all pending claims 1 – 19.

secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space” as set forth in claim 1. Applicants respectfully disagree and urge that this position by the Examiner is not only contrary to the interpretation previously asserted by the Examiner, but remains unsupported by Tagami.

More specifically, the Examiner contends that determining a rendering characteristic for each of the primary color and the secondary color from the two-color input data is taught by Tagami. The rejection alleges that such a limitation is taught by “a two color input data from like the ones needed in highlight printers ((duotone)) need a Ink source Language where the user defines his colors ((like for example the duotone colors)) and the output is define by the colors and screens/rendering- characteristic. See Column 1, Lines 16-35 and 39-55, See Column 3, Lines 15-27 and 55-66).” The referenced background text in col. 1 describes the use of a highlight color in printing whereas the text of col. 3 is directed to the description of Fig. 1, and the header of an Ink Catalog. Applicants respectfully urge that a general discussion of highlight color printing and the format of an ink catalog header fails to disclose determining a rendering characteristic for each of the primary color and the secondary color from the two-color input data as required by claim 1.

Next, the Examiner alleges that the limitation of representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output, based upon the rendering characteristics, and the primary and secondary colors is taught by Tagami. This is alleged to be described by a screen set definition ((SCNSET)) at Column 5, Lines 3-23 and 33-42, Column 6, Lines 29-67, Column 7, Lines 1-42, Column 8, Lines 36-67, Column 12, Lines 12-55, and Column 15, Lines 60-67. Applicants respectfully maintain that, having failed to identify where Tagami teaches determining a rendering characteristic for each primary color, reliance on Tagami to teach further limitations that require the rendering characteristics would also be unsupported. As for col. 5, the teachings appear to be related to a palette structure (Fig. 5) and screen set pattern. No rendering characteristic is described, nor is there a suggestion of its use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics.

Column 6, Lines 29-67 refer to a texture directory as depicted in Fig. 9, and describes textures within a palette. Once again, Applicants respectfully submit that such a teaching fails to disclose a rendering characteristic for each primary color, nor their use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics. As for Column 7, Lines 1-42, this is a continuation from the end of Column 6 and relates to the description of Fig. 10, the SCNSET definition, and includes the number of definitions, maximum distance, percentages of black and highlight color. The balance of Column 7 is directed to the description of Fig. 11, a screen definition. Again, neither Figs. 10 or 11, nor the discussion thereof are believed to result in a teaching of a rendering characteristic for each primary color, nor a suggestion of their use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics as recited in claim 1.

Column 8, Lines 36-67 are also apparently urged as teaching the limitations of claim 1. The cited portions of Column 8 appear to be directed to a description of Fig. 13, which is a color definition. Here, the color definition is described as including an index for two primaries, although one may be zero if only one primary is used in the color. Character words are used to reference or locate the bitmaps for the color, as well as an offset to a screen to be used for the color. No teaching is believed to be found for the recited rendering characteristics for each primary color, or use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics. Column 12, Lines 12-55, describe an ink compiler, "a non-print time, stand alone utility that allows a user to create specific inks that can be used on the printer system" (Column 12, lines 13-16). Applicants again maintain that such a disclosure fails to teach the recited limitations, but that the teaching of an ink compiler would appear to be contrary to the intent and claims of the instant application (e.g., claim 1, "method for converting input data representing a color formed from only two primary colors to output data representing a color in a full color space) as well as Herron. Applicants respectfully submit that such teachings by Tagami are further indicia that the rejection improperly seeks to combine the disclosures.

Lastly, Column 15, Lines 60-67, are directed to defining screens or a screenset, which is taught to be a collection of halftone screens. Applicants once again maintain that the teaching of screens or sets of screens does not give rise to the teaching of a rendering characteristic for each primary color, nor a suggestion of their use to represent a combination of the primary and secondary colors as an intermediate output, based upon

the rendering characteristics, as recited in claim 1. In view of the examples above, among others, that illustrate the failure of Tagami to teach limitations that it has been relied upon in the rejection, the rejection itself is improper relative to claim 1 and should be withdrawn.

Applicants further contend that processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space is also not taught by Tagami, Column 7, Lines 43-67, Column 9, Lines 39-67, Column 14, Lines 15-43, or otherwise. Hence, the final limitation of claim 1 is also not taught by Tagami.

Accordingly, on its face, the current rejection again fails to establish *prima facie* obviousness as the Examiner has acknowledged that Herron (Current Action, p. 5) and Tagami (June '08 Action, p. 3) both fail to teach that limitation. Alternatively, those portions of Tagami now alleged as teaching the previously acknowledged omissions, likewise fail to teach the specific limitations of independent claim 1, and specific examples have been provided. Whether considered alone or in combination, Herron and Tagami fail to teach all of the limitations set forth in independent claim 1. Hence the rejection is traversed, and claim 1 is respectfully urged to be in condition for allowance. Withdrawal and immediate indication of allowance is respectfully requested.

As for dependent claims 2-5, these claims all depend from now presumably allowable claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to independent claim 1. For purposes of brevity, specific arguments of patentability are not presented herein but are respectfully reserved for a subsequent response or on appeal.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 24-0037 for Xerox Corporation.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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